

DETAILED ACTION

The RCE is acknowledged. The prior rejections are withdrawn. See the new ground(s) of rejection below.

Election/Restrictions

Newly submitted claim 18 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are directed to a sheet of camouflage pattern including mimic patterns of moths not in the originally presented article claims. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 18 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,924,131 to Wilkinson.

Wilkinson teaches an article such as a piece of clothing for hunting using a camouflage pattern. A photograph of any scene in nature including trees, leaves (embraces plants), and a forest (where a plurality of insects like moths and their parts exist commingled with plants) wherein select portions of the images are selected on portions of clothing using pattern software to mimic the nature environments. See Abstract, FIG. 4, 2:20-50, 3:10-16, and 4:10-60, 5:1-40. Claims 1, 5, and 17 are addressed in part.

Wilkinson doesn't explicitly teach only the portions of wings of a moth or butterfly (claims 1, 5, and 17), but as aforesaid, moths and their inherent parts exist in nature and thus it would have been obvious to one having ordinary skill in the art to envision moth patterns since they exist in nature and aid in concealment

It has been held that mere printed matter having no new or unobvious functional relationship between the printed matter and the substrate is unpatentable. See *In re Gulack*, 703 F.2d 1381, 217 U.S.P.Q. 401 (Fed. Cir. 1983). The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See *In re Seid* 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

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Though we are fully cognizant of the hindsight bias that often plagues determinations of obviousness, Graham v. John Deere Co., 383 U.S. 1, 36 (1966), we are also mindful that "the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007).

Attention is directed to the following regarding the obviousness of first and second images

- Printing a plurality of images on an article is known in the art as provided by Wilkinson set forth above and are purely decorative in nature.
 - It has been held that mere printed matter having no new or unobvious functional relationship between the printed matter and the substrate is unpatentable. See *In re Gulack*, 703 F.2d 1381, 217 U.S.P.Q. 401 (Fed. Cir. 1983).
 - The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See *In re Seid* 161 F.2d 229, 73 USPQ 431 (CCPA 1947).
- Manipulating design elements and adjusting the ranges of the decorative wing and plant image portions are within skill of the art.
 - It has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284.
 - It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Thus, given that the prior art accounts for various patterns, the plurality of wings and plant images instantly claimed are obvious and optimizable for providing decoration and concealment to the article absent unexpected results or criticality.

Response to Arguments

Applicant's arguments are moot in view of the new ground(s) of rejection above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on 571-272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tamra L. Dicus /TLD/
Examiner
Art Unit 1794

October 27, 2009

/Jennifer McNeil/
Supervisory Patent Examiner, Art Unit 1794